

REMARKS

Claims 1-10, 20-25, and 27-30 are pending.

Rejection under 35 U.S.C. § 103

Claims 1, 2, 7, 8, 10, and 20 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,389,028 to Bondarenko et al. ("Bondarenko") in view of U.S. Patent No. 4,788,715 to Lee ("Lee"), and further in view of U.S. Patent Pub. No. 2003/0061354 to Burg et al. ("Burg"). Claims 3, 5, and 6 stand rejected under 35 U.S.C. §103 as being unpatentable over Bondarenko in view of Lee, in view of Burg, and further in view of U.S. Patent No. 6,049,603 to Schwartz et al. ("Schwartz"). Claims 4 and 9 stand rejected under 35 U.S.C. §103 as being unpatentable over Bondarenko in view of Lee, in view of Burg, and further in view of U.S. Patent No. 6,335,744 to Korilis et al. ("Korilis"). Claims 21-23, 25, 27, and 28 stand rejected as being unpatentable over Bondarenko in view of Burg, and further in view of Schwartz. Claims 24 and 29 stand rejected under 35 U.S.C. §103 as being unpatentable over Bondarenko in view of Burg, in view of Schwartz, and further in view of Korilis. Claim 30 stands rejected under 35 U.S.C. §103 as being unpatentable over Bondarenko in view of Burg.

1. Even when combined, the references do not teach the claimed subject matter.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with the pending claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim

must be evaluated.

Claims 1-10 and 20

Claim 1 recites *inter alia* an ACD server comprising an SIP server. The Examiner concedes that this feature is not taught by Bondarenko either alone or in combination with Lee, but submits that the deficiencies of the Bondarenko/Lee combination in this regard are remedied by Burg. Applicant respectfully traverses the Examiner's position for the following reason.

In particular, as pointed out by the Examiner, Burg discloses an IP gateway comprising an SIP proxy server; Burg clearly fails to teach or suggest an ACD server comprising an SIP server, as clearly recited in independent claim 1.

Accordingly, claim 1 is allowable over the cited references for at least the foregoing reason. Claims 2-9 depend from and further limit claim 1 and are therefore allowable for at least the same reason as claim 1.

Claims 10 and 20 include similar limitations to those of claim 1, described above, and are therefore allowable for at least the same reason as claim 1.

Claims 21-25 and 27-29

Claim 21 recites *inter alia* an ACD server comprising an SIP server. The Examiner concedes that this feature is not taught by Bondarenko, but submits that the deficiencies of the Bondarenko in this regard are remedied by Burg. Applicant respectfully traverses the Examiner's position for reason set forth above with reference to claim 1.

In particular, as pointed out by the Examiner, Burg discloses an IP gateway comprising an SIP proxy server; Burg fails to teach or suggest an ACD server comprising an SIP server, as clearly recited in independent claim 21.

Accordingly, claim 21 is allowable over the cited references for at least the foregoing reason.

Additionally, claim 21 recites, *inter alia*, responsive to the user terminating the call before the ACD server transfers the call to a live agent, tracking how much time the user has been on hold and prioritizing the user within the queue the next time the user calls back. The

Examiner concedes that this feature is not taught by Bondarenko either alone or in combination with Burg, but submits that the deficiencies of the Bondarenko/Burg combination in this regard are remedied by Schwartz. Applicant respectfully traverses the Examiner's position for the following reason.

In particular, Schwartz fails to teach or suggest "tracking how much time the user has been on hold"; indeed, the portion of Schwartz cited by the Examiner as teaching this feature teaches only determining a current wait time for a caller and providing the caller with a priority code should the caller prefer not to continue on hold. There is no mention of tracking the amount of time the user has been on hold.

Accordingly, claim 21 is allowable over the cited references for at least the foregoing additional reason.

Claims 22-25 and 27-29 depend from and further limit claim 21 and are therefore allowable for at least the same reasons as claim 21.

Claim 30

Claim 30 recites *inter alia* an ACD server comprising an SIP server. The Examiner concedes that this feature is not taught by Bondarenko, but submits that the deficiencies of the Bondarenko in this regard are remedied by Burg. Applicant respectfully traverses the Examiner's position for the reason described above with reference to claim 1.

In particular, as pointed out by the Examiner, Burg discloses an IP gateway comprising an SIP proxy server; Burg fails to teach or suggest an ACD server comprising an SIP server, as clearly recited in independent claim 30. Accordingly, claim 30 is allowable over the cited references for at least the foregoing reason.

2. The references are not properly combinable as the references do not teach or suggest the combination.

There is still another compelling, and mutually exclusive, reason why the Bondarenko, Lee, and Burg references cannot be combined and applied to reject independent claims 1, 10, and 20, under 35 U.S.C. §103, the Bondarenko, Burg, and Schwartz references cannot be combined and applied to reject independent claim 21 under 35 U.S.C. §103, and the Bondarenko and Burg references cannot be combined and applied to reject independent claim 30 under 35 U.S.C. §103.

The PTO also provides in MPEP §2142:

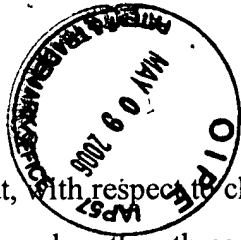
[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, references do not teach, or even suggest, the desirability of the various combinations thereof. Indeed, none of the references provides any incentive or motivation supporting the desirability of the combinations. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of claims 1, 10, 20, 21, and 30.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in any of the references for the combinations as variously applied to claims 1, 10, 20, 21, and 30. Applicant's position in this regard is bolstered



by the fact that, with respect to claims 1, 10, 20, and 21, the Examiner has picked and chosen elements from no less than three separate references in an attempt to recreate Applicant's invention as recited in those claims. While the number of references combined by the Examiner is not, alone, conclusive evidence of nonobviousness, it is certainly a factor to be considered.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the pending independent claims and the rejection under 35 U.S.C. §103 is not applicable.

Conclusion

It is respectfully submitted that all the claims in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the telephone number provided below.

Respectfully submitted,

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